

Applicants: Thomas M. Jessell, et al.  
U.S. Serial No: 09/820,598  
Filed: March 29, 2001  
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**REMARKS**

Claims 27, 38, 45, 48, 49, 50, 52, 60 and 125-130 are pending in the subject application. The Examiner has indicated that claim 126 is allowable. Applicants have hereinabove cancelled claims 38, 45, 49, 50, 52, 60, 129 and 130 without prejudice or disclaimer to their right to pursue the subject matter of these claims in a later-filed application. In addition, applicants have hereinabove amended claim 27. These amendments do not involve any issue of new matter. Therefore, entry of this amendment is respectfully requested such that claims 27, 48 and 126-128 will be pending and under examination.

In view of the arguments set forth below, applicants maintain that the Examiner's rejections have been overcome and respectfully request that the Examiner reconsider and withdraw the various grounds of rejection.

**Formalities**

Applicants acknowledge the Examiner's withdrawal of the following rejections: (i) the rejection of claims 27, 45, 48, 49, 50, 52, 60, 127 and 128 under 35 U.S.C. §112, second paragraph; (ii) the rejection of claims 27, 127 and 128 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement; and (iii) the rejection of claims 27, 45, 48, 49, 50, 52, 60, 127 and 128 under 35 U.S.C. §112, first paragraph, for lack of enablement.

**Claim Rejection Under 35 U.S.C. §112, first paragraph**

The Examiner maintained the rejection of claims 45, 49, 50, 52 and 60 under 35 U.S.C. §112, first paragraph, as allegedly

failing to comply with the enablement requirement. The Examiner stated that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner stated that these claims are drawn to methods of treating neurological diseases/injuries by administering the MNR2 protein to a subject, thus causing differentiation of neuronal precursor cells. The Examiner stated that these methods are not art-recognized such that there could be a nexus between other prior art proteins and the treatment of neurological diseases/injury and MNR2.

The Examiner stated that the issue isn't whether one could administer a protein to a subject, but whether that protein will be active *in vivo* to accomplish the methods claimed. The Examiner stated that the specification does not teach how one would administer the MNR2 protein to induce differentiation of neural progenitor cells into somatic motor neurons in a subject, treat a subject with abnormally associated functioning motor neurons, treat a subject with neurodegenerative diseases, treat a subject with acute nervous system injury, or treat a subject with neuromuscular disease because the MNR2 protein has not been administered *in vivo* and the art does not recognize MNR2 or similar proteins for use in these methods. The Examiner stated that there are no examples provided, and there is no analogous art to create a predictable nexus for the use of MNR2 in these methods. The Examiner concluded that the methods claimed are not enabled.

In response, applicants respectfully traverse. Nevertheless, without conceding the correctness of the Examiner's position and to expedite prosecution of the subject application,

applicants have hereinabove cancelled claims 45, 49, 50, 52 and 60 without prejudice or disclaimer to their right to pursue these claims in a later-filed application. Applicants contend that this amendment obviates the above rejection and respectfully request that the Examiner reconsider and withdraw this ground of rejection.

**Claim Rejection Under 35 U.S.C. §112, second paragraph**

The Examiner rejected claims 27, 45, 48, 49, 50, 52, 60 and 127-128 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated that claim 27 states that the fragment will have the biological activity of the MNR2 protein. The Examiner stated that the specific activity that the fragment is to have is not set forth in the claim, rendering the claim indefinite.

In response, applicants respectfully traverse. Nevertheless, applicants without conceding the correctness of the Examiner's position and to expedite prosecution of the subject application, have hereinabove amended claim 27 such that it no longer recites a fragment of MNR2.

Applicants contend that these remarks obviate the above rejection and respectfully request that the Examiner reconsider and withdraw this ground of rejection.

**Summary**

For the reasons set forth hereinabove, applicants respectfully request that the Examiner reconsider and withdraw the various

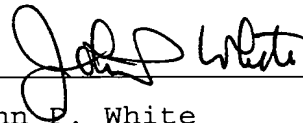
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grounds of rejection and objection and earnestly solicit allowance of the pending claims.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.


No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

 7/26/06  
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John P. White                      Date  
Reg. No. 28,678